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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,800

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Peter Gibson

22409-00316-US

6209

30678

7590

06/23/2010

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EXAMINER

BERTRAM, ERIC D

ART UNIT

PAPER NUMBER

3766

MAIL DATE

DELIVERY MODE

06/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,800	Applicant(s) GIBSON ET AL.	
	Examiner Eric D. Bertram	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-14,17-23 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-14,17-23 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/2010 has been entered.

Response to Arguments

2. Applicant's arguments filed 5/24/2010 have been fully considered but they are not persuasive. The applicant argues that none of portions 3, 4, 7 and 8, all of which are pliable and extend outwardly from a housing 2, can be considered flanges, since they do not encompass the ordinary meaning of the word, that being "a flat surface sticking out from an object for affixing the object to something or making it stronger." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Furthermore, even if these features were claimed, the portions of Berrang can still be considered "flanges". All of the portions are relatively flat, and stick out from housing 2. Furthermore, all of the portions can be affixed to the skull if so desired by a

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user. As admitted by the applicant, on page 8 of the Remarks, the specification only requires the flanges to be “securable.” All of the portions of Berrang are “securable”. For example, Berrang discloses that portion 3 may be sutured to the body (par. 0089). Furthermore, all of the flanges are bendable by hand. Specifically, portions 7 and 8 are described to “expand with minimal stress during surgical handling” (par. 0076). Furthermore, portions 3 and 4 include portion 6, which is “pliable (or bendable)” (par. 0068). All of the structural limitations required by the claims are met. The 35 USC 102(b) rejections of claims 1, 3, 4, 6-14, 17-23 and 26-30 are still considered proper.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 4, 6-14, 17-23 and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Berrang et al. (US 2002/0019669, hereinafter Berrang).

6. Regarding claims 1, 23 and 31, Berrang discloses a medical implant as shown in figure 1 configured to be implanted at least partially within a well formed in an outer surface of a skull bone of a recipient (par. 0088). A low profile hermetically sealed housing 2 has a length and width that are substantially greater than a thickness between an upper and lower surface of the housing (see figure 1 and par. 0080). The housing 2 has a pliable flange 3 extending outwardly from it, such that the flange is

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bendable by hand such that the flange fits substantially flush against the surface of the skull (par. 0069, 0078 and 0088). As seen in figures 6 and 8, the housing 2 defines a plane configured to match a plane of the outer surface of the skull bone. Both the housing 2 and the flange 3 are securable to the skull by sutures or screws, which would require orifices passing through the housing and the flange (par. 0022 and 0089).

7. Regarding claims 3 and 4, the implant is a receiver/stimulator package of a cochlear implant (par. 0018).

8. Regarding claim 6, Berrang discloses that the wells are formed by a surgical excavation of the skull (par. 0088).

9. Regarding claim 7, the housing 2 also has flanges 4, 7 and 8 extending outwardly therefrom (see figures 1 and 3).

10. Regarding claim 8, as seen in figure 1, flange 4 and flanges 7 and 8 extend in substantially opposite directions relative to each other.

11. Regarding claims 9-12 and 18, the flange 3 is connected to, and thus extends from, the upper, lower and middle surfaces of housing 2 (see figure 2).

12. Regarding claims 13, 14, 21 and 23, bridge structure 6 acts as a plate, an engagement member and/or a clip mounted to the housing 2, and engaging both the housing and the flange (see figure 2).

13. Regarding claim 17, Berrang discloses the flange 3 to have a thickness of 2.0-2.9 mm (par. 0070).

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14. Regarding claim 20, the flange may inherently be removed from the housing by breaking it off, even though it may not be reattached (which is not required by the claim).

15. Regarding claim 26, the implant comprises titanium, stainless steel and plastic, among other materials (see par. 0023 and claim 18).

16. Regarding claims 19 and 27, Berrang discloses the use of welding in order to attach parts together (par. 0018 and 0025).

17. Regarding claims 28 and 29, the housing and flange are coated with silicone (par. 0080).

18. Regarding claim 30, a receiver coil 4 also extends from the housing and is positioned on the outer surface of the skull (see figure 3 and par. 0068).

Conclusion

19. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D. Bertram whose telephone number is (571)272-3446. The examiner can normally be reached on Monday-Thursday from 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on 571-272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric D. Bertram/
Examiner, Art Unit 3766